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09/783,224	02/14/2001	Steven R. Slawson	281-345	1587

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EXAMINER

NGUYEN, THONG Q

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 03/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/783,224

Applicant(s)

SLAWSON ET AL.

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/26/02, 4/15/02 and 6/24/02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-13,15-30,32,33 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5,11-13, 15-17, 23-27, 29, 32-33 and 35 is/are rejected.
- 7) ☒ Claim(s) 6-10,18-22,28 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the amendments (Paper Nos. 6, 8 and 9) filed on 3/19/02; 3/28/02 and 6/24/02.

It is noted that the claims 2, 14 and 34 were canceled as indicated in the amendment filed on 3/19/02 and claims 31 and 36 were canceled as indicated in the amendment filed on 3/28/02; thus the pending claims now are claims 1, 3-13, 15-30, 32-33 and 35.

Drawings

2. The corrected or substitute drawings were received on 3/19/02. These drawings are approved by the Examiner.

Specification

3. The lengthy specification which is amended by the amendments has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 32-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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a) Claim 32 is rejected under 35 USC 112, second paragraph because the feature thereof "said lens assembly comprises an outer ear viewing assembly" (lines 1-2) is confusing with the feature "a retina viewing device" recited in its base claim 29. In particular, since the base claim recites a retina viewing device then it is unclear how the retina device can contain a lens assembly for viewing an ear.

b) Claim 33 is rejected for the similar reason as set forth in element a) above.

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 3-4, 11, 13, 15-16 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Carlin (U.S. Patent No. 3,371,660).

Carlin discloses an optical apparatus for examining/observing a patient's eye.

The apparatus as described at columns 1-3 and shown in figures 1-2 comprises a housing (7) having an observer end and a patient end, and an eyecup (5) which is removably attached to the patient end of the housing (7). The eyecup (5) comprises a patient end and an observing end wherein the patient end comprises a flange configured bottom surface sized to substantially correspond to the eye orbit of the patient's eye and an interior sized to accommodate a patient's eyelashes; and the observing end is removably attached to the patient end of the housing (7).

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8. Claims 1, 3, 5, 13, 15, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Krasnicki et al (U.S. Patent No. 4,930,507).

Krasnicki et al disclose a retina viewing system having a housing (11) with an observer side and a patient side and an eyecup made by soft pliable material attached to the patient side of the housing. See column 3 and figs. 1-2, for example. As a result of using soft, pliable material for the eyecup then a contact of the eyecup to the area around the patient's eye will inform the observer about the operation position of the device.

9. Claims 29 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Yarush et al (U.S. Patent No. 5,879,289, of record).

Yarush et al disclose a hand-held endoscope system. The endoscope system comprises a housing having an operator end and a patient end; an attachment interface in the form of a lens tube (32) connected at the patient end of the housing; and an attachment disposed in the attachment interface. At columns 16-19 and shown in figure 12(a-f), the attachment can be an eyecup or an otoscope.

Claim Rejections - 35 USC § 103

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
11. Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlin (U.S. Patent No. 3,371,660).

Carlin discloses an optical apparatus for examining/observing a patient's eye.

The apparatus as described at columns 1-3 and shown in figures 1-2 comprises

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a housing (7) having an observer end and a patient end, and an eyecup (5) which is removably attached to the patient end of the housing (7). The eyecup (5) comprises a patient end and an observing end wherein the patient end comprises a flange configured bottom surface sized to substantially correspond to the eye orbit of the patient's eye and an interior sized to accommodate a patient's eyelashes; and the observing end is removably attached to the patient end of the housing (7).

While Carlin does not positively disclose a method for operating his device for reviewing a patient's eye; however, it would have been obvious to one skilled in the art at the time the invention was made to utilize the device provided by Carlin for viewing a patient's eye by designing a set of steps including the step of installing an eyecup (5) on the patient end of a housing (7); and then moving the device towards the patient's eye until it touch the area defined by the eyebrow and the upper cheekbone area around the patient's eye.

12. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlin in view of Luning et al (U.S. Patent No. 3,390,931).

Carlin discloses an optical apparatus for examining/observing a patient's eye.

The apparatus as described at columns 1-3 and shown in figures 1-2 comprises a housing (7) having an observer end and a patient end, and an eyecup (5) which is removably attached to the patient end of the housing (7). The eyecup (5) comprises a patient end and an observing end wherein the patient end comprises a flange configured bottom surface sized to substantially correspond

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to the eye orbit of the patient's eye and an interior sized to accommodate a patient's eyelashes; and the observing end is removably attached to the patient end of the housing (7).

While Carlin does not positively disclose that the material of the eyecup is an opaque material as claimed; however, the use of an eyecup material made by opaque material for preventing ambient light and the walls of the flexible eyecup is thinner in the direction facing the observer's eye is disclosed in the art as can be seen in the system provided by Luning et al. See column 3. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the device of Carlin by using opaque material for making an eyecup as suggested by Luning et al for the purpose of preventing ambient light entering into the field of view defined between the patient's eye and the observer.

13. Claims 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krasnicki et al.

Krasnicki et al disclose a retina viewing system having a housing (11) with an observer side and a patient side and an eyecup made by soft pliable material attached to the patient side of the housing. See column 3 and figs. 1-2, for example. As a result of using soft, pliable material for the eyecup then a contact of the eyecup to the area around the patient's eye will inform the observer about the operation position of the device.

While Krasnicki et al does not positively disclose a method for operating his device for reviewing a patient's eye; however, it would have been obvious to one

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skilled in the art at the time the invention was made to utilize the device provided by Krasnicki et al for viewing a patient's eye by designing a set of steps including the step of installing an eyecup (5) on the patient end of a housing (7); and then moving the device towards the patient's eye until it touch the area defined by the eyebrow and the upper cheekbone area around the patient's eye.

14. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krasnicki et al in view of Luning.

Krasnicki et al disclose a retina viewing system having a housing (11) with an observer side and a patient side and an eyecup made by soft pliable material attached to the patient side of the housing. See column 3 and figs. 1-2, for example. As a result of using soft, pliable material for the eyecup then a contact of the eyecup to the area around the patient's eye will inform the observer about the operation position of the device.

While Krasnicki et al does not positively disclose that the material of the eyecup is an opaque material as claimed; however, the use of an eyecup material made by opaque material for preventing ambient light and the walls of the flexible eyecup is thinner in the direction facing the observer's eye is disclosed in the art as can be seen in the system provided by Luning et al. See column 3. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the device of Krasnicki et al by using opaque material for making an eyecup as suggested by Luning et al for the purpose of preventing ambient

light entering into the field of view defined between the patient's eye and the observer.

15. Claims 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yarush et al (U.S. Patent No. 5,879,289) with or without Monroe et al (U.S. Patent No. 5,662,5860).

The device as provided by Yarush et al meets all of the limitations of the device as claimed in claims 33 and 35 except the feature concerning the type of attachment disposed in the attachment interface. In other words, Yarush et al do not clearly state that the attachment can be an episcopes or a corneal lens viewing assembly, etc.... However, the use of such attachments is merely that of a preferred embodiments and no criticality has been disclosed. The support for that conclusion is found in the present specification. It is also noted that the attachment in the form of an eyecup or an otoscope is indeed claimed as can be seen in present claim 32. Furthermore, the interchangeability of an otoscope and an episcopes is clearly suggested to one skilled in the art as can be seen in the system provided by Monroe et al. See column 4 and fig. 2. Thus, absent any critical features concerning the structure, it would have been obvious to one skilled in the art at the time the invention was made to utilize any suitable attachment including an episcopes or a corneal viewing lens, etc... as an attachment for the system provided by Yarush et al for the purpose of satisfying a desired application.

Response to Arguments

16. Applicant's arguments filed on 3/28/2002 have been fully considered but they are not persuasive.

With regard to the rejection of claims 29 and 32 under 35 USC 102(b) over the art of Yarush et al, applicant's arguments provided in the amendment (Paper No. 8, page 3) have been fully considered but they are not persuasive. It is noted that applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Further, the subject matter recited in the claims is disclosed by Yarush et al. In particular, Yarush et al disclose a hand-held endoscope system. The endoscope system comprises a housing having an operator end and a patient end; an attachment interface in the form of a lens tube (32) connected at the patient end of the housing; and an attachment disposed in the attachment interface. At columns 16-19 and shown in figure 12(a-f), the attachment can be an eyecup or an otoscope and the device can be used to observe a skin or any section of a human body.

Allowable Subject Matter

17. Claims 6-10, 18-22, 28 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

18. The additional references are cited as of interest in that each discloses an optical viewing system having an eyecup.

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

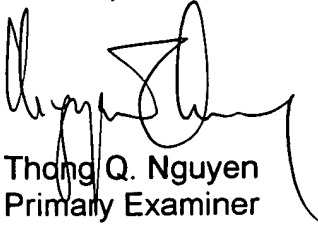
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is 703 308 4814. The examiner can normally be reached on M-F.

The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 7724 for regular communications and 703 308 7724 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen
Primary Examiner
Art Unit 2872

February 25, 2003